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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,661	09/13/1999	MASAAKI TSUJI	2271/60220	4670

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EXAMINER

RIMELL, SAMUEL G

ART UNIT PAPER NUMBER

2164

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/394,661

Applicant(s)

TSUJI, MASAOKI

Examiner

Sam Rimell

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamura et al. (U.S. Patent 6,075,920).

Claim 3: FIG. 1 of Kawamura et al. discloses a control unit (20) which controls a first generating portion (9) which generates time code information. The control unit (20) itself is a second generating portion that generates non-time-code information, such as sector number, copyright management information, track number, application ID number, application information and layer information (see right arrow extending from control unit). The time code information and non-time-code information are each components of subcode that are entered into a subcode generator (11) which outputs subcode. The control unit maintains controls over the output of the time code information and non-time-code information, and thus can be read as a selecting portion which selects output. The control unit (20) processes first and second commands. The first command is from the control unit (20) to time code generator (9) to generate time codes (col. 9, lines 24-25). The second command is a command received and processed by the control unit (20) to generate the non-time code information (col. 10, lines 24-32). The commands are inherently saved within portions of memory within the system of FIG. 1. Additionally, it is observed that the time code information has a plurality of components (FIG. 11) and the non-time code information has a plurality of components (sector number, copyright

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management information, track number, application ID number, application information and layer information, as seen in FIG. 1). Also note table of FIG. 6, which is a data table in memory having separate table locations (memory areas) for metadata (commands) associated with the time code data and non-time code data.

Claim 4: The second generating portion (control unit) outputs six types of data, and can thus be said to comprise a plurality of generating portions. Also note the table of FIG. 6, which is a data table in memory having separate table locations (memory areas) and metadata (commands) for time code data and non-time code data.

Claim 5: The time code generating portion (9) and the generating portion indicated by the right arrow extending from the control unit (20) are readable as toggle generating portions since they generate subcode components which are delivered to the subcode encoder (11). The subcode can be said to “toggle” in the sense that it is created by changing a field of bits to a different field of bits. For example, FIG. 18 indicates that the subcode for the track number occupies a field having a length of 2 bytes. The field is inherently changed when the field gets encoded with track number information. Thus, the subcode field containing this information can be said to toggle between an uncoded “low state” and an encoded “high state”. The control unit (20) reads as the selecting portion since it maintains control over the entry of subcode components into the subcode encoder (11).

#### Remarks

The rejection of claim 5 under 35 USC 112, 1<sup>st</sup> paragraph has been vacated in view of applicant's amendments. However, the amendments have triggered as new grounds of rejection under 35 USC 102.

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Applicant's arguments are primarily directed to claims 3-4, and assert that the Kawamura et al. reference does not disclose commands stored in memory that generate subcode component data. This argument is not correct. Kawamura et al. explicitly discloses first and second commands which generate subcode data. The first command is from the control unit (20) to the time code generator (9) to generate time codes (col. 9, lines 24-25). The second command is received by the control unit (20) from an input unit to generate non-time code information (col. 10, lines 24-32). The commands are programmed instructions and are inherently stored within the memory of the system of FIG. 1. For example, the first command originating from the control unit (20) would logically be stored in the control unit (20), while the second commands originating from an input unit (col. 10, lines 24-32) would logically be stored in the input unit.

This office action follows the filing of an RCE request and is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell  
Primary Examiner  
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